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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,218	05/22/2006	Francisco Casas Salva	5326-17	1853
23117 7590 10/05/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
CLEMENT, MICHELLE RENEE				
ART UNIT		PAPER NUMBER		
3641				
MAIL DATE		DELIVERY MODE		
10/05/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/580,218

**Applicant(s)**

CASAS SALVA, FRANCISCO

**Examiner**

Michelle (Shelley) Clement

**Art Unit**

3641

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-31, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-31, 33, 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 9/1/09 have been fully considered but they are not persuasive. In response to applicant's contention that Leek does not show a barrel and screws that fix the barrel to the rifle support, applicant is directed to the figures. Leek clearly shows a barrel (reference 1) and several screws (reference 7, Figures 3 and 5), that fix the barrel to the rifle support. The screws (7) tighten the rifle support in a manner to hold (i.e. fix) the barrel. Figure 3, clearly shows a protective cover that covers an area of the rifle support including the heads of the screws (7). Applicant's contention that Leek "teaches away from conventional structures that are used to fix the barrel to the rifle support" is irrelevant, in that Leek discloses the claimed elements, whether they are "conventional" is not germane to the claims.
2. The Sasaki reference is directed to a protective cover that covers heads of screws. The Sasaki reference has solved a similar problem as that encountered by Leek, i.e. covering screw heads. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24-27, 29-31, 33 and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Leek et al (US Patent # 3,023,527) in view of Sasaki (US Patent # 5,294,013). Leek et al. discloses a rifle comprising a rifle support, a projectile propulsion mechanism comprising a barrel, screws that fix the barrel to the rifle support and a protective cover that covers an area on the rifle support including heads of the screws to protect a user therefrom, the protective cover comprising a main body having a predetermined length and width corresponding to a length and width of the area to be covered on the rifle support. The main body is configured in size and shape such that at least part of a perimeter portion thereof mates with and is received in a recess formed on an exterior surface of the rifle support. The main body is transversally convex towards an exterior thereof and longitudinally elongated. The cover comprises a single piece. Although Leek et al. does not expressly disclose the specific fixing device that fixes the main body to the area to be covered, Sasaki does. Sasaki teaches a fixing device that fixes a main body to an area to be covered (the area to be covered including heads of screws), the fixing device comprising one or more deformable protrusions on the main body that push-fit mate with one or more corresponding recesses on the rifle support. The fixing device comprises at least two deformable protrusions that push-fit mate with at least two recesses that receive and fit around the deformable protrusions. The deformable protrusions have a mushroom shape. Further

comprising a positioning device that positions the main body on the support, comprising a plurality of positioning projections formed on an interior surface of the main body of the cover and a plurality of positioning recesses formed on the area to be covered, the plurality of positioning recesses receiving corresponding ones of the plurality of positioning projections to properly position the main body of the cover on the area to be covered. Wherein the one or more corresponding recesses on the support comprise generally cylindrical recesses and wherein a diameter of the cylindrical recesses changes along a depth of the cylindrical recesses, the diameter of the cylindrical recesses being greater at greater depths in the cylindrical recesses (Figures 16A-16C). Because both references teach devices for covering and protecting devices for covering screws on a support, it would have been obvious to one skilled in the art to substitute one device for the other to achieve the predictable result of covering screws. It is noted that the product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps; “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 227 USPQ 964. Regarding the process for making the claimed projectile or the **Product by Process** Claims, applicant is direct to MPEP § 2113 cited in the prior office action. Therefore cover formed by injection molding is not pertinent in this instance to the patentability of this product claim. The references disclose the claimed invention except for the cover expressly of the plastic material (Sasaki discloses a flexible material). It would have been

obvious to one having ordinary skill in the art at the time the invention was made to make the cover of plastic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leek et al. in view of Sasaki as applied to claim 24 above, and further in view of Rickenbacher (US Patent # 2,308,627). Although neither Leek et al. nor Sasaki expressly disclose the exterior surface of the main body being smooth or having the ability to bear graphic printed information on an exterior surface, Rickenbacher does. Rickenbacher teaches a cover for covering a surface, the cover having a smooth surface and having the ability to bear graphic printed information. It would have been obvious to one of ordinary skill in the art to use the smooth surface as taught by Rickenbacher with the cover as produced by Leek et al. and Sasaki to provide a decorative cover for a firearm as suggested by Rickenbacher.

### ***Conclusion***

This is an RCE of applicant's earlier Application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle (Shelley) Clement/  
Primary Examiner, Art Unit 3641